

5.(Once Amended) The equipment carrier of Claim 2, wherein said cart further comprises an elongated, hollow, tubular handle formed of a U-shape and pivotally mounted to inside external circumferential sidewalls of said main frame at said anterior end thereof.

7.(Once Amended) The equipment carrier of Claim 1, wherein said bottom end of said athletic bag rests against said base member such as to form a bag mounting platform to serve as a base upon which a base of said athletic bag is permanently attached.

REMARKS

Reconsideration of the application as amended is respectfully requested.

The examiner respectfully rejected Claims 4 and 7 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The specification as well as Claims 3, 4, 5, and 7 have been amended so as to overcome the aforementioned rejection under 35 U.S.C. 112, second paragraph.

The examiner respectfully rejected Claims 1 and 6 under 35 U.S.C. 102(b) as being anticipated by Allen.

In undertaking to determine whether one reference anticipates another under 35 U.S.C. 102(b), a primary tenet is that the reference must teach every element of the claim. "A claim is

anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Many differences exist between the invention claimed in Allen and the currently claimed invention. To briefly summarize the distinguishing features and characteristics between the two, Allen teaches an athletic bag for carrying, storing and airing out athletic equipment.

However, Allen fails to *claim* a two-wheeled cart. In contrast, Allen merely *claims* wheel members in Claim 11, thus failing to claim specifically a *two-wheeled cart*.

In addition, unlike the present invention, Allen fails to *claim* an athletic bag incorporating a *cart*. *-it is a cart by virtue of combination of handle 28, wheels, + supportive bag structure*

Furthermore, in contrast to the present invention, Allen fails to *claim* an athletic bag fabricated of a *weatherproof, flexible, heavy fabric*. Allen, rather, claims a *common fabric*, a *fabric enclosure*, and a *fabric enclosure member*, as stated in claims 7, 8, and 13 respectively.

Therefore, in light of the numerous differences between Allen and the present invention, the examiner's rejection of Claims 1 and 6 under 35 U.S.C. 102(b) as being anticipated by Allen is inappropriate.

The examiner respectfully rejected Claims 1-5 and 7 under 35 U.S.C. 103(a) as being unpatentable over Allen in view of Weldon. The differences with respect to Allen have been

stated above.

Weldon teaches a portable cooler caddy which includes a cup holder panel.

However, unlike the present invention, Weldon fails to teach an athletic bag, and hence also fails to teach an athletic bag with a bottom end permanently attached to the base member of the main frame.

In addition, unlike the present invention, Weldon fails to teach an inflating pump attached to an upright member of the main frame.

Examiner argues it would have been obvious to one of ordinary skill in the art at the time the invention was made to attach a hand-operated inflating pump to the main frame.

However, in light of the failure by each of the aforementioned references to disclose the attachment of such inflating pump to an athletic carrier as taught by the present invention, the attachment of such component is nonobvious.

The examiner respectfully rejected Claim 8 under 35 U.S.C. 103(a) as being unpatentable over Allen in view of Pratt et al. Pratt et al. teaches a golf ball holder mountable to a golf bag, golf cart, belt, or the like.

However, based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. 103(a), in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument applicant wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. 103, the cited

references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Argues: no suggestion
each ref presents the benefits of its structure
- Allen = protective, wheeled bag ; weldon = supportive frame structure
- prot = storage ability of ball holders

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself.

Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985). There is nothing in the prior art or the examiners arguments that would suggest the desirability or obviousness of the combination of features of the wheeled, portable, collapsible athletic equipment carrier. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (CAFC 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or

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suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ.2d 1529 (CAFC 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (CAFC 1988).

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (CAFC 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (CAFC 1988).

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and is requested.

Respectfully submitted,



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operated inflating pump securely attached to an outer, elongated sidewall of [the] an upright member of [the] said main frame in a linear fashion so as to provide a means for inflating sports balls requiring inflation.

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7.(Once Amended) The equipment carrier of Claim 1, wherein said bottom end of said athletic bag rests against [the] said base member such as to form a bag mounting platform to serve as a base upon which [the] a base of [the] said athletic bag is permanently attached.



VERSION WITH MARKINGS TO SHOW CHANGES MADE

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In the Specification

- On page 5, line 7, delete the word "Velcro®" and replace with --VELCRO®--.
- On page 5, line 14, delete the word "Velcro®" and replace with --VELCRO®--.
- On page 6, line 7, delete the word "Velcro®" and replace with --VELCRO®--.
- On page 10, line 16, delete the word "Velcro®" and replace with --VELCRO®--.
- On page 11, line 5, delete the word "Velcro®" and replace with --VELCRO®--.
- On page 12, line 3, delete the word "Velcro®" and replace with --VELCRO®--.

In the Claims

Please amend the following claims by deleting the language which is enclosed in brackets "[]" and inserting the language which is underlined "_____".

3.(Once Amended) The equipment carrier of Claim 2, wherein said cart further comprises:

a support stand having an elongated, hollow, cylindrical U-shaped configuration affixed to lower external circumferential sidewalls of [the] said U-shaped portion of [the] said base member at corners so as to provide structural stability thereto.

4.(Once Amended) The equipment carrier of Claim 1, further comprising a hand-